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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,468	06/23/2003	Alex J. Draughon	03292.101700	7233

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30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/601,468	Applicant(s) DRAUGHON ET AL.	
	Examiner Ponnoreay Pich	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's election of group I (claims 1-8) in the reply filed on 5/18/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

#### ***Response to Arguments***

With respect to claim 8, applicant argues that Montville does not teach the limitations as currently amended. The examiner respectfully disagrees. Please see citations and explanations below on how Montville meets the amended limitations.

Applicant's arguments with respect to claim 1 were considered but were not persuasive. Applicant noted that with respect to claim 1, the examiner stated that one skilled would have been motivated to combine the teachings of Meyers with Montville because "message alert was a common feature in many email client at the time applicant's invention was made" and because "it allows a user to know when messages are available without constantly having to check manually". With respect to these motivations given applicant argues that the requisite motivation to combine the teachings of Meyer and Montville has not been established in the office action because simply because a feature of a similar device was common at the time of the invention does not make it obvious to add the feature to the system described in Montville. The examiner respectfully disagrees. The fact that similar systems to Montville at the time applicant's invention was made all made use of a common feature would have more than made obvious to one of ordinary skill in the art to also implement this common

feature within Montville's invention. The fact that many email clients at the time applicant's invention was made utilized a message alert system shows that this was a popular feature that one of ordinary skill would have continued to incorporate in developing future email clients, such as the one disclosed by Montville. Also, as discussed in the office action, one skilled would also be motivated to incorporate this feature disclosed by Meyers because it allows a user to know when new messages are available without having to constantly and manually check.

Applicant argues that because the way messages are gathered and presented by Montville, there would be no reason or motivation for Montville's system to add a message alert for the simple reason that all new messages arrive in a message "inbox" and the header information is viewed. Applicant states that Montville's system is designed to avoid the need to use message alerts because the system checks for new messages based on the frequency the subscriber has determined and the header information is placed in the inbox. Applicant states that there is no reason to notify a subscriber of a waiting message if the subscriber is already in the process of checking for messages.

The examiner respectfully submits that applicant seems to be misconstruing the examiner's rejection. It is true that Montville's system is designed to automatically check for messages from multiple sources and display the header information in an "inbox" without the manual intervention of a subscriber. However, the subscriber of Montville's system still needs to manually log-in and check the "inbox" of his invention to determine if any messages have been received from any of the multiple sources

checked by Montville's invention. Until the user actually logs in and checks the inbox, the user has no idea if any new messages/headers were delivered to the inbox. The Universal Messaging system disclosed in the Background of the Invention section of Meyers discloses of a message alert system whereby a user is notified of new messages automatically via use of an indicator light or even an automatic outdial phone call. Incorporating such an automatic alert system as disclosed by Meyers with Montville's invention would allow a user to be alerted once Montville's invention has gathered new messages into the discussed "inbox" of his invention. It is not the need to manually check all the other message sources that Meyers's teachings would be useful for avoiding if integrated within Montville's invention. Meyers's teachings would instead be useful for avoiding having to manually and constantly log-in and check the discussed "inbox" of Montville's invention which contains the messages from multiple sources.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Instead of "the recipient", the examiner assumes that in line 9 of claim 1, applicant meant to recite "the intended recipient". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Montville et al (US 6,356,937).

**Claim 8:**

Montville discloses a private message (col 24, lines 55-58) stored and associated with a first identifier (col 21, lines 49-51) and a second identifier (col 22, lines 58-65 and col 26, lines 34-40), wherein the first and second identifiers are associated with a first user, i.e. the EMC subscriber, and wherein the first identifier includes an account number (col 21, lines 49-51) and the second identifier includes a combination of a user identification and a password (col 22, lines 58-65 and col 26, lines 34-40).

Note that the user/recipient's email address as indicated in the "to" field of an email message is considered the first identifier. Based on applicant's definition of what is an "account number" on page 7 of the specification, the recipient's email address can be considered an account number. The user/recipient has to log into a server using a user name and/or identification name and password combination to access the message stored by Montville's EMC application, thus the private message is stored and associated with both a first and second identifier.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montville et al (US 6,356,937) in view of Meyer (US 6,148,329).

**Claim 1:**

Montville discloses:

1. Storing a message in a database (col 27, lines 37-42).
2. Associating the message with an intended recipient by a first identifier (col 21, lines 49-51 and col 24, lines 55-67). *The receiver's email address as indicated in the "to" field in the email message can be considered the first identifier. Any other identifier that is used by Montville's invention to identify the various email accounts checked by his invention can also be considered the first identifier.*
3. Providing a web site for the intended recipient to view the message (col 5, lines 38-40 and col 15, lines 50-55).
4. Authenticating the intended recipient using a second identifier, i.e. user and/or identification name (col 6, lines 38-42 and col 26, lines 34-40).
5. Searching the database to find messages for the intended recipient by matching the first identifier (col 24, lines 55-67).
6. Displaying the message for the intended recipient (col 26, lines 51-55).

Montville does not explicitly disclose the following limitation, which is disclosed by Meyers: notifying the intended recipient of the message stored in the database (col 1, lines 14-21).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to incorporate Meyers's teachings within Montville's invention according to the limitations recited in claim 1. One skilled would have done so by automatically alerting the user of Montville's invention when the EMC application has downloaded new messages or headers into the "inbox" of the EMC application from any one of the multiple accounts specified by the user. One skilled would have been motivated to incorporate Meyers's teachings within Montville's invention because message alert is a common/popular feature in many email client at the time applicant's invention was made and it would allow a user to know when new messages are available, i.e. downloaded by the EMC application, without constantly having to manually check.

**Claim 2:**

Montville further discloses wherein said first identifier is an account number (col 21, lines 49-51 and col 24, lines 55-67).

Note that on page 7, lines 8-15 of applicant's specification, "account number" is very broadly defined as pretty much identifier/indicia configured to allow the consumer to interact or communicate with the system. One skilled should appreciate that a user's email address allows a user to communicate using the modified invention of Montville and Meyers, thus can be considered an account number. The account identifiers which identifies the various email accounts of the user and is stored in the e-mail account book (col 23, lines 55-67) can also be considered account numbers because they allow the user to receive emails, i.e. communicate, using Montville's system.

**Claim 3:**



Montville further discloses wherein the second identifier is a combination of a user identification and a password (col 6, lines 38-42 and col 26, lines 34-40).

**Claim 5:**

Montville further discloses wherein the message includes: a message portion; and an attachment file in a format that is different from said message portion (Fig 13; col 23, line 61-col 24, line 4; and col 24, lines 17-19).

**Claim 6:**

Montville further discloses a step of encrypting the website to view messages using an encryption method (col 25, lines 44-53).

**Claim 7:**

Montville further discloses wherein the encryption method is SSL (col 25, lines 44-53).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montville et al (US 6,356,937) in view of Meyer (US 6,148,329) and further in view of Fung et al (US2002/0055909).

**Claim 4:**

As per claim 4, Montville and Meyers does not explicitly disclose said second identifier is a biometric identification system. However, Fung discloses an identifier being a biometric identification system (paragraphs 148-149).

At the time applicant's invention was made, it would have been obvious to one skilled in the art to further modify Montville's invention such that he second identifier is a biometric identification system. One skilled would have been motivated to do so because biometric authentication allow for greater confidence in verifying someone's identity (Fung: paragraph 148).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

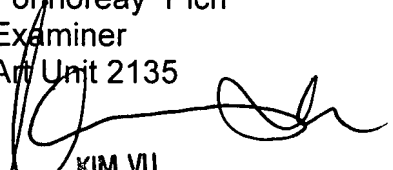
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

Ponnoreay Pich  
Examiner  
Art Unit 2135



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